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EXAMINER

PICH, PONNOREAY

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/787,722

Applicant(s)

CHEVREAU ET AL.

Examiner

Ponnoreay Pich

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9 is/are allowed.
- 6) ☒ Claim(s) 1, 3-5 and 7-11 is/are rejected.
- 7) ☒ Claim(s) 2, 6 and 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

Claims 1-12 are pending.

### ***Response to Arguments***

Applicant argues Linnartz does not disclose, "identifying whether said digital data are watermarked" and in fact there is no need in Linnartz to identify whether the digital data are watermarked. The examiner respectfully disagrees.

Linnartz uses watermark detection to control playback and recording of digital data. Column 2, lines 10-19 discuss detection of watermark in digital data. In column 5, lines 4-10, Linnartz further discusses that playback of the content is dependent on the state of the watermark. If the watermark does not exist, then the content is considered to be in a free copy state and if the watermark exists, then there are playback restrictions that are dependent on the watermark, physical mark, and authorization mark. To identify what state the digital content is in (i.e. states a-d), Linnartz's invention must identify/determine whether or not the digital content is watermarked. As evidenced by the existence of the free copy state (i.e. state d) where digital data is not watermarked, digital data are not automatically assumed to be watermarked in Linnartz's invention as applicant seems to be implying.

With respect to applicant's arguments that the combination of Linnartz and Ranger does not make obvious identifying whether digital data are encrypted and delivering one of a permission and a prohibition to copy and/or to play said digital data as a function of and identification of: an encryption of said digital data; and a

Art Unit: 2135

watermarking of said digital data, these arguments were persuasive and the rejections in the last office action are withdrawn. Upon consideration of applicant's remarks, the examiner believes while Ranger teaches identifying whether the digital data are encrypted, the combination of Linnartz and Ranger would result in a system which identified whether data are encrypted and whether they are watermarked. However, the permission or prohibition to copy and/or to play the digital data in the resulting combination system would only be a function watermarking of said digital data since the identification of encryption as per Ranger's teachings is only used to decide whether the data needs to be decrypted first to scan for viruses. Nonetheless, upon further consideration of claim 1, the examiner believes that it could be rejected based on Linnartz's teachings alone. As understood in the art, a digital signature can be obtained using a cryptographic algorithm applied to the digital data. Thus when it is recited in claim 1 "identifying whether said digital data are encrypted", the limitation could be interpreted to mean identifying whether the digital data was signed using a hashing algorithm where the digital data was the input. As will be further discussed below, Linnartz teaches this and the other limitations recited in claim 1.

The rest of applicant's remarks were also fully considered, but are moot in view of new rejections made below.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

Art Unit: 2135

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, 8, and 10-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Linnartz (US 6,314,518).

**Claim 1:**

Linnartz discloses:

1. Identifying whether said digital data are encrypted (col 7, lines 64-67). *Signing the digital content means that a one way cryptographic algorithm was applied to the content. Identifying whether or not a signature of the content exists means identifying whether the digital content was encrypted, i.e. processed using the one way cryptographic hash algorithm.*
2. Identifying whether said digital data are watermarked (col 2, lines 10-19 and col 5, lines 4-10). *Note that before allowing the content to be played, the content is checked for a watermark, which would define what state the content is in.*
3. Delivering one of a permission and a prohibition to copy and/or to play said digital data as a function of an identification of:
  - a. An encryption of said digital data (col 7, lines 64-67); and
  - b. A watermarking of said digital data (col 5, lines 1-10 and 42-52 and col 7, lines 64-67).

**Claim 3:**

Linnartz further discloses delivering a permission for digital copying when: an encryption of said digital data has not been identified; and a watermarking of said digital data has not been identified (col 5, lines 1-10). The cited portion discloses that content, if it lacks a watermark is considered to be in state d, a free copy state. There being no watermark means that the watermark has not been identified and the data being in a free copy state means a copy permission is delivered whether or not encryption of digital data is identified.

**Claim 4:**

Linnartz further discloses delivering a prohibition of playing of said digital data when: an encryption of said digital data has not been identified; and a watermarking of said digital data has been identified (col 4, lines 30-47).

**Claim 5:**

Linnartz further discloses:

1. Identifying the type of storage medium (col 4, lines 1-45).
2. Delivering a prohibition of copying when:
  - a. An encryption of digital data has been identified (col 7, lines 64-67). *Only if the content was signed by a compliant and authorized device would the recorder be allowed to copy content. This means that if the signature is identified as being signed by a non-compliant or unauthorized device, the recorder would be prohibited from copying.*
  - b. A watermarking of said digital data has been identified (col 5, lines 1-10 and 42-52 and col 7, lines 64-67).

- c. A recordable type of storage medium has been identified (col 4, lines 1-18 and col 5, lines 35-44).

**Claim 8:**

Linnartz further discloses wherein the prohibition of digital copying comprises a blocking of output of the digital data (col 4, lines 1-3).

**Claim 10:**

Linnartz further discloses identifying the type of storage medium; and delivering one of a permission and a prohibition to copy and/or to play said digital data as a further function of the identification of a recordable or non-recordable type of storage medium (col 4, lines 1-45).

**Claim 11:**

Linnartz further discloses identifying whether a cryptographic signature accompanies said digital data (col 8, line 63-col 9, line 41); and delivering one of a permission and a prohibition to copy and/or to play said digital data as a further function of the identification of a cryptographic signature accompanying said digital data (col 8, line 63-col 9, line 8).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 2135

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Linnartz (US 6,314,518) in view of Ichinoi (US 6,266,477).

**Claim 7:**

Linnartz does not explicitly disclose the following limitations, but they are disclosed by Ichinoi:

1. Converting the digital data into analog signals (col 3, lines 4-7 and col 4, lines 19-30).
2. Corrupting the analog signals if a prohibition of digital copying is delivered (col 11, lines 21-35).

At the time applicant's invention was made, it would have been obvious to one of ordinary skill in the art to modify Linnartz's invention according to the limitations recited in claim 7 in light of Ichinoi's teachings. One skilled would have been motivated to incorporate Ichinoi's teachings in which digital data is converted to analog signals because Ichinoi recognizes that there are still technology that consumers have which are analog in nature, thus there exists a need in the art for digital systems to be backwards compatible with these analog systems (col 1, lines 23-33 and col 2, lines 13-18). One of ordinary skill would have been motivated to incorporate Ichinoi's teachings of corrupting the analog signals if a prohibition of digital copying is delivered because it would help prevent copying of protected material (col 11, lines 33-35).



***Allowable Subject Matter***

Claim 9 is allowed.

Claims 2 and 6 would be allowable if rewritten to include all of the limitations of the base claim and any intervening claims. Claim 12 would also be allowed due to dependency on claim 2 if claim 2 were rewritten to include all the limitations of the base claim and any intervening claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ponnoreay Pich whose telephone number is 571-272-7962. The examiner can normally be reached on 9:00am-4:30pm Mon-Thurs.

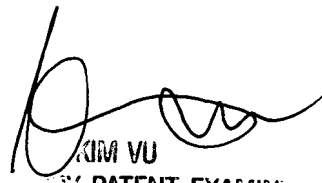
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2135

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ponnoreay Pich  
Examiner  
Art Unit 2135

PP



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